



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,723	01/17/2001	Yasuo Koishihara	53466/295	4861

22428 7590 05/30/2003

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007

EXAMINER
----------

EWOLDT, GERALD R

ART UNIT	PAPER NUMBER
----------	--------------

1644

DATE MAILED: 05/30/2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/760,723

Applicant(s)

Koishihara

Examiner  
G.R. Ewoldt, Ph.D.

Art Unit  
1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Mar 11, 2003

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

4)  Claim(s) 13-24 is/are pending in the application.

4a) Of the above, claim(s) 14 is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 13 and 15-24 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892) 4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

2)  Notice of Draftsperson's Patent Drawing Review (PTO-948) 5)  Notice of Informal Patent Application (PTO-152)

3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). 3, 7 6)  Other: \_\_\_\_\_

**DETAILED ACTION**

1. Applicant's election of the species: B cells and autoimmune disease, in Paper No. 20, filed 3/11/03, with traverse, is acknowledged. Applicant traverses the species requirement on the grounds that each of the diseases at issue implicates both T and B cells.

Applicant's argument has been fully considered but has not been found convincing. Whereas certain conditions, such as allergy, are primarily considered to be B cell-mediated, other conditions, such as certain autoimmune diseases, e.g., multiple sclerosis are primarily considered to be T cell-mediated. While the searches may overlap, they are not co-extensive. Accordingly, the election of species requirement is maintained.

The species requirements are still deemed proper and are therefore made FINAL.

2. Claim 14 is withdrawn from further consideration by the Examiner, under 37 C.F.R. § 1.142(b) as being drawn to a nonelected species.

Claims 13 and 15-24 are being acted upon.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 20-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the laboratory designation "HM1.24" is vague and indefinite as it is unclear precisely which antibody is encompassed by the claims. Laboratory designations cannot be held constant outside of the laboratory in which they are used, accordingly, the antibody of the instant invention is preferably identified by ATCC Accession Number.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at

the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 13 and 15-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,298,420 (1994) in view of Goto, T., et al. (1994, IDS).

The '343 patent teaches a method of inhibiting B lymphocyte activation (by killing the lymphocyte) for the treatment of an autoimmune disease or a B cell cancer comprising administering a monoclonal antibody which binds B cells (see particularly column 1, lines 27-39 and column 6, lines 45-57).

The reference teaching differs from the claimed invention only in that it does not teach the use of the chimeric, humanized monoclonal antibody HM1.24 which binds SEQ ID NO:1.

Goto, T., et al. teaches the use of the chimeric, humanized monoclonal antibody HM1.24 which binds SEQ ID NO:1 on terminally differentiated B cells for the treatment of multiple myeloma (see particularly page 1922, column 2, paragraph 1 and page 1929, column 1 paragraph 1).

It would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made to perform a method of inhibiting B lymphocyte activation (by killing the lymphocyte) for the treatment of an autoimmune disease, comprising administering a monoclonal antibody, as taught by the '343 patent, employing the humanized monoclonal antibody HM1.24 which binds SEQ ID NO:1, as taught by Goto, T., et al. as the specific monoclonal antibody. One of ordinary skill in the art at the time the invention was made would have been motivated to use the HM1.24 because said antibody was known to selectively bind terminally differentiated B cells, as taught by Goto, T., et al., and would thus, be an obvious choice for the elimination of said cells and the treatment of any disease (such as a B cell-mediated autoimmune disease) which said cells mediate. Note that the substitution of equivalents, in this instance different B cell-binding antibodies, is considered to be obvious.

7. No claim is allowed.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Gerald Ewoldt whose telephone number is (703) 308-9805. The examiner can normally be reached Monday through Thursday from 7:00 am to 5:00 pm. A message may be left on the examiner's voice mail

service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1 at (703) 305-3014. The CM1 Fax Center telephone numbers are 703-872-9306 (before final) and 703-872-9307 (after final).



G.R. Ewoldt, Ph.D.  
Primary Examiner  
Technology Center 1600  
May 29, 2003